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09/491,094	01/24/2000	Robert C. Heath	1975.99C	8089
7303	7590	03/24/2005	EXAMINER	
FRANK J CATALANO FRANK J CATALANO, P.C. 100 WEST 5TH ST., 10TH FLOOR TULSA, OK 74103-4990			HYLTON, ROBIN ANNETTE	
			ART UNIT	PAPER NUMBER
			3727	

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/491,094
Filing Date: January 24, 2000
Appellant(s): HEATH ET AL.

Frank J Catalano
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 13, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-3 and 2-3 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,961,510	Dvoracek	10-1990
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(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3 are rejected under 35 U.S.C. 102 (b). This rejection is set forth in a prior Office Action, mailed on September 10, 2004.

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Claims 2 and 3 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on September 10, 2004.

(11) Response to Argument

Appellant's claims are drawn only to a lid. The walls forming the "clamp" for attaching the lid of Dvoracek to a container is structurally equivalent to that which is claimed. The lid of Dvoracek is shown in an associated position on a beverage container, or can. The arrangement provided therebetween is a sealed engagement. This is necessary to prevent leaks and spills at the engagement junction and between the lid and its associated container.

Appellant asserts the closure rim is not "clamped" to the associated container of Dvoracek, but merely captures a ridge on the container rim. Wherein the claimed invention of only a lid is set forth, the limitation of "clamping" an associated container rim is intended use of the lid. While the disclosure sets forth an engagement with a beverage can, the lid of Dvoracek is capable of clamping onto a cup rim which is of a thickness slightly larger than the width between the inner and outer lips of the clamp. One using the lid for attachment to a container in the form of a cup, would only use the lid on a container cup which would be provided with a sealed engagement. Said sealed engagement would only come from using the lid on a container cup having a rim thickness slightly greater than the width of the clamp.

Thus, in response to appellant's argument that the lid of Dvoracek does not clamp a container cup rim, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136

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USPQ 458, 459 (CCPA 1963). The intended use of the claimed lid does not establish patentability over the art of record.

Regarding appellant's remarks at page 6, paragraph 2 of the appeal brief, as appellant is well aware a patent is not required to disclose every possible embodiment of the invention, only the preferred embodiment. While it is true Dvoracek does not disclose the lid is attached to a container cup, the lid is capable of being used with a cup. In so doing, it would clamp the rim as discussed previously. Appellant's reliance on the engagement of Dvoracek's lid to a beverage can as shown does not negate the fact that only a lid is claimed.

Regarding the arguments at page 8, paragraph 2 (of the appeal brief) directed to the frustoconical shape of the spout, the spout of Dvoracek is substantially frustoconical. As seen the figures, the spout allows for smooth flow of beverage from the associated container as appellant asserts in the above cited remarks. The rejection is to set forth that smoother lines can be formed and would be obvious to one of ordinary skill in the art. Thus, making the spout more frustoconical.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



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RAH
March 21, 2005

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